

REMARKS

The Examiner previously made a restriction requirement between claims 1-14 (hot melt pressure sensitive adhesive) and claims 15-25 (roofing membrane). Applicant wishes to affirm the previous election of claims 1-14 with traverse. Applicant submits that as the Examiner has already conducted a search of all of the claims (see Office Action mailed November 18, 2005), there is no additional burden on the Examiner to examine all of the claims in a single application. Accordingly, Applicant respectfully requests that the Examiner examine all of the claims.

In the latest Office Action, claims 1, 4-5 and 7-11 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-10 of copending Application No. 10/935,142. Upon indication that the claimed subject matter is otherwise allowable, Applicant will submit a properly executed terminal disclaimer to obviate this provisional rejection.

Claims 1, 3, 4, 7-8, and 10 have been rejected under 35 U.S.C. 102(e) as being anticipated by Schmidt (U.S. 6,482,281). Schmidt teaches a hot melt adhesive for use on vehicle lights or headlamps which comprises thermoplastic elastomers, poly- α -olefins, tackifiers, and polyisobutylenes. However, Schmidt does not teach or suggest a composition in the form of a tape on a release liner as recited in claim 1, as amended. Basis for this amendment may be found in the specification at page 9, lines 10 and 22. Nor would there be any motivation for Schmidt to provide his composition in the form of a tape as his composition is not used in such a configuration or for the purpose of adhering roofing materials. Schmidt does not anticipate the composition of claims 1, 3, 4, 7-8, and 10, as amended.

Nor does Schmidt teach or suggest an adhesive composition which, when adhered to a roofing membrane, exhibits the claimed peel strength or supports the claimed static load recited in new claims 26 and 27.

Claims 2, 5-6, 9, and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt. The Examiner has taken the position that it would have been obvious for Schmidt to have arrived at the claimed range of thermoplastic elastomers (15-20% by weight) because Schmidt teaches that the amount of thermoplastic may be as high as 15 wt%. However, there is no teaching or suggestion in Schmidt of using an amount up to 20 wt% as claimed by applicants. Claims 2, 5-6, 9 and 11-12 depend directly or indirectly from claim 1. There is no motivation to modify Schmidt as discussed above with respect to claim 1 as Schmidt is not directed to an adhesive for adhering together roofing materials as claimed.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt in view of Ardegmani (US 4,072,735). Claim 14 has now been cancelled, and the subject matter of claim 14 has been incorporated into amended claim 1. The Examiner has cited Ardegmani for teaching a release liner in combination with a hot melt pressure sensitive adhesive, asserting that it would have been obvious to use a release liner with the adhesive of Schmidt. As pointed out above, there is no motivation to modify Schmidt as his adhesive composition is not used to adhering roofing materials together as claimed. An assertion that one skilled in the art could modify a reference, or an assertion that a proposed modification is within the level of skill in the art are not proper bases for a conclusion of obviousness absent a proper motivation, teaching, or suggestion in the prior art to do what applicant is claiming. See, *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed.Cir. 1990); *Ex parte Levingood*, 28 USPQ2d 1300 (PTO BPAI 1993); and MPEP § 2143.01. The Examiner has not shown that Schmidt's adhesive is in the form of a tape which would require a protective release liner.

Applicant notes that claim 13 is indicated as being allowable if rewritten in independent form. However, with the amendments to claim 1, claim 13 is believed to be allowable in its present form.

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For all of the above reasons, applicant submits that claims 1-13, as amended are in condition for allowance. Early notification of allowance is respectfully requested.

Respectfully submitted,

DINSMORE & SHOHL LLP

By Susan M. Luna
Susan M. Luna
Registration No. 38,769

One Dayton Centre
One South Main Street, Suite 1300
Dayton, Ohio 45402-2023
Telephone: (937) 449-6429
Facsimile: (937) 449-6405